

REMARKS

The last Office Action has been carefully considered.

It is noted that claims 1, 2, and 4 are rejected under 35 U.S.C. 102(b) over the patent to Mark.

Claims 1-7 are rejected under 35 U.S.C. 103(a) in view of the patent to Mattner in view of the patent to Mark.

Also, the claims are rejected under 35 U.S.C. 112 and the specification is objected to.

In connection with the Examiner's formal objections and rejections, applicants have amended the specification, canceled the original claims and submitted a new set of claims including claim 8, the broadest claim on file.

It is respectfully submitted that the new features of the present invention, which are now defined in claim 8, are not disclosed in the references applied by the Examiner against the original claims.

Turning now to the references and particularly to the patent to Mark, it should be mentioned that this reference does not disclose in a single

word of which material the anchor described in the reference is made. Even if the drawings of this reference are considered to determine of what material the anchor is composed, they also do not show that the expansible sleeve consists of hardened steel.

The Examiner rejected the original claims over the patent to Mark under 35 U.S.C. 102 as being anticipated. In connection with this, it is believed to be advisable to cite the decision in *re Lindenman Maschinenfabrik GmbH v. American Hoist & Derrick Co.*, 221 USPQ 481, 485 (Fed. Cir. 1984) in which it was stated:

"Anticipation requires the presence in a single prior art reference disclosure of each and every element of the claimed invention, arranged as in the claim."

Definitely, the patent to Mark does not disclose each and every element of the present invention as defined in claim 8, and therefore the Examiner's original rejection of the claims as anticipated by this reference should be considered as no longer tenable and should be withdrawn.

The patent to Mattner discloses in column 5, lines 10-15 that the cutting edges are formed preferably by hardened regions of the expansion tabs. Alternatively, Mattner proposes to use special cutting inserts. This also means that the expansion sleeve in this reference is not completely composed of hardened steel. Furthermore, the patent to Mattner does not disclose straight

bending lines. It is therefore believed to be clear that this reference does not teach the new features of the present invention which are now defined in claim 8.

As for the rejection of the claims over the combination of the references, it should be mentioned that the patent to Mattner only disclose that the cutting edges must have an increased hardness. Neither the patent to Mattner nor the patent to Mark propose however to make the complete expansion sleeve of a hardened material. In the prior art there is a danger of breaking (brittle fracture) of the expansion tongs of the expansion sleeve. Also, the patent to Mark does not provide a solution for this problem by the straight bending lines, since this reference deals with reduction of radial forces acting on the wall of the borehole, as explained in column 1, lines 60-66. The anchor disclosed in the patent to Mark is not provided with cutting edges, but instead is inserted in a borehole which already has an undercut.

It is believed to be clear that none of the references teaches the new features of the present inventions which are now defined in claim 8, and these features can not be derived from the combination of the references, since the references, first of all, can not be combined as a matter of obviousness, and secondly the combination would not lead to the applicant's invention as defined in claim 8. In order to arrive at the applicant's invention, the references had to be fundamentally modified by including into them the features which were first proposed by the applicants.

However, it is known that in order to arrive at a claimed invention, by modifying the references the cited art must itself contain a suggestion for such a modification.

This principle has also been consistently upheld by the U.S. Court of Customs and Patent Appeals which, for example, held in its decision in re Randol and Redford (165 USPQ 586) that

Prior patents are references only for what they clearly disclose or suggest. It is not a proper use of a patent as a reference to modify its structure to one which prior art references do not suggest.

Also, the present invention, as explained herein above, provides for the highly advantageous results which can not be accomplished by the construction disclosed in the references. It is well known that in order to support a valid rejection in the art must also suggest that it would accomplish applicant's results. This was stated by the Patent Office Board of Appeals, in the case Ex parte Tanaka, Marushma and Takahashi (174 USPQ 38), as follows:

Claims are not rejected on the ground that it would be obvious to one of ordinary skill in the art to rewire prior art devices in order to accomplish applicant's result, since there is no suggestion in prior art that such a result could be accomplished by so modifying prior art devices.

In view of the above presented remarks and amendments, it is believed that claim 8, the broadest claim on file, should be considered as patentably distinguishing over the art and should be allowed.

As for the dependent claims, these claims depend on claim 8, they share its presumably allowable features, and therefore it is respectfully requested that they should be allowed as well.

Reconsideration and allowance of the present application is most respectfully requested.

Should the Examiner require or consider it advisable that the specification, claims and/or drawings be further amended or corrected in formal respects in order to place this case in condition for final allowance, then it is respectfully requested that such amendments or corrections be carried out by Examiner's Amendment, and the case be passed to issue. Alternatively, should the Examiner feel that a personal discussion might be helpful in advancing this case to allowance, he is invited to telephone the undersigned (at 631-549-4700).

Respectfully submitted,

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